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Attorney's Docket No.: 02103-452001
Client's Ref. No.: AABOSS63

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Number of pages including this page 5

Applicant : David E. Hanson et al.
Serial No. : 10/810,930
Filed : March 26, 2004

Art Unit : 3747
Examiner : Andrew M. Dolinar

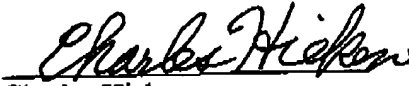
Title : Controlled Starting and Braking of an Internal Combustion Engine

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attached to this facsimile communication cover sheet is Response A to Restriction Requirement, faxed this 8th day of July, 2005, to the United States Patent and Trademark Office.

Respectfully submitted,
FISH & RICHARDSON P.C.

Date: July 8, 2005.


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Serial No. : 10/810,930
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Title : CONTROLLED STARTING AND BRAKING OF AN INTERNAL
COMBUSTION ENGINE

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Mail Stop Amendment
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE A TO RESTRICTION REQUIREMENT

Responsive to the office action dated June 8, 2005, application owner respectfully traverses the requirement for restriction and provisionally elects claim 1-17 and 48-52 in Group I for further prosecution in this application should the requirement not be withdrawn.

35 U.S.C. §121 reads, "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." Thus, restriction is proper only if the inventions are "independent and distinct." M.P.E.P. headed 802.01, "Meaning of 'Independent', 'Distinct' reads as follows:

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

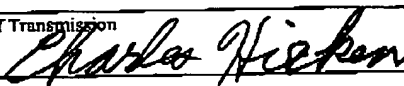
DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate

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Charles Hicken

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manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term "related" is used as an alternative for "dependent" in referring to subjects other than independent subjects.

The Examiner has not shown that the claims in each group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." Should the requirement for restriction be made final, the Examiner is respectfully requested to rule that the claims in each Group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

The Examiner has made no showing whatsoever that the inventions are INDEPENDENT. M.P.E.P. 803 provides, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

And M.P.E.P. 803.01 provides, "IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION."

Manifestly, search and examination of the entire application can be made without serious burden because prior art related to the engine starting must be searched in connection with examining the claims in the other groups.

The Court of Customs and Patent Appeals has also recognized that "independent and distinct" means "independent and distinct." *In re Weber*, 198 U.S.P.Q. 328 (C.C.P.A. 1978); *In re Haas*, 198 U.S.P.Q. 334, 336 (C.C.P.A. 1978).

In a decision dated June 23, 1977, on a petition filed June 13, 1977, Group 1210 Director Alfred L. Leavitt in granting the petition to withdraw the requirement for restriction said:

Current Office policy is not to require restriction between related inventions when no substantial burden is involved in the examination of all claims in a single application.

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And in a decision dated 3 December 1993 on a petition filed March 12, 1993, Group 1100

Deputy Director John Doyle said:

Restriction was required between (I) method for epitaxial deposition and (II) epitaxially deposited product (Paper No. 4). However, the examiner failed to present any convincing basis for the holding that the inventions as above grouped are distinct. The claimed inventions must be independent or distinct, and the examiner "must provide reasons and/or examples to support conclusions . . .". Further, the field of search for the alleged distinct inventions is seen to be coextensive, hence, no serious burden is seen to be incurred by examination of all pending claims. MPEP 803 under "Criteria For Restriction Between Patentably Distinct Inventions".

The Petition is GRANTED.

That inventions I, II and III are related as subcombinations that are usable together in a single combination has nothing to do with the requirements of establishing that the groups are both independent and distinct and that search and examination of the entire application cannot be made without serious burden. The concession that the groups are related as subcombinations that are usable together in a single combination requires a conclusion that the groups are not independent.

Manifestly, search and examination of the entire application can be made without serious burden because prior art which must be searched in connection with examining claims 1-17 and 48-52 related to the claimed engine starting is likely to disclose subject matter related to the remaining claims.

Claim 1 in Group I calls for selecting a cylinder being located in a predetermined position along its stroke. Claim 18 in Group II recites a controlled barking process to reduce engine speed from a first speed to a second speed. Claim 34 in Group III recites determining a range of speeds so the engine may be stopped to have crank shaft angles fall within a desired range. Groups I, II and III rely on each other's particular features recited in respective claims exemplified by limitations quoted above from claims 1, 18 and 34, for example. For example, the invention of Group II of reducing engine speed is basically a consequence of wanting to do engine stopping in accordance with the invention of Group III, at least in the context of enabling an engine to position the pistons for self-starting. For self-starting, the engine is preferably

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stopped in a position such that it may be restarted, clearly linking the inventions of Group I for engine starting and Group III for engine stopping.

Moreover, the three groups of claims are classified together in closely related sub-classes of class 123, such as 179.4 including automatic engine stop, 179.5 including control of spark ignition during starting, 198DB including fuel cut-off, 198DC including ignition cut-off control, 322 including electrical means adapted to alter valve timing and 325 including deceleration responsive cutoff of fuel to engine.


Accordingly, it is respectfully requested that the requirement for restriction be withdrawn. If the requirement for restriction is repeated, the Examiner is respectfully requested to rule the claims in each group are PATENTABLE (novel and unobvious) OVER EACH OTHER and explain why all the claims cannot be examined without serious burden.

No fee is believed to be due. However, the commission is respectfully requested to charge any fees to Deposit Account No. 06-1050, Order No. 02103-452001.

Respectfully submitted,
FISH & RICHARDSON P.C.

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